

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB 5/22/00

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Joseph Davis Suthern
v.
Federal Ideas, Inc.

Opposition No. 88,475
to application Serial No. 74/132,354
filed on January 22, 1991

REQUEST FOR RECONSIDERATION AND/OR REHEARING

Robert W. Dickerson of Lyon & Lyon LLP for Joseph Davis
Suthern

Federal Ideas, Inc., pro se.

REQUEST FOR REHEARING

Before Sams, Chief Administrative Trademark Judge:

Applicant has requested reconsideration of the Board's
February 1, 2000 decision sustaining this opposition, and
has addressed a request to the Chief Administrative
Trademark Judge for a rehearing of the case by a different

panel of judges. For the reasons discussed below, applicant's request for a rehearing of the case is denied.¹

Essentially, it is applicant's contention that its due process rights have been violated by the Board's inclusion of Administrative Trademark Judge Bottorff as one of the members of the three-judge panel assigned to the final hearing and decision of this case; that Judge Bottorff's presence on the panel "tainted" the other two judges on the panel, and that applicant accordingly is entitled to a rehearing of the case by three new judges.

More specifically, applicant contends that Judge Bottorff was incapable of rendering an independent decision in this case due to a "conflict of interest" arising from his prior familiarity with the case and his prior status as the interlocutory motions attorney responsible for this case, and that applicant is entitled to have its case heard by three judges who had no such prior familiarity or knowledge of the case. Applicant cites no legal authority for this argument, and the Chief Judge is aware of no such authority. In the absence of any showing that Judge Bottorff is biased or otherwise incapable of impartially reaching a decision, the mere fact that he was previously involved in the case as the Board's interlocutory motions attorney provides no basis for requiring his recusal. To

¹ The decision of the original three-judge panel on applicant's

the extent that applicant's request for rehearing is based on that mere fact of Judge Bottorff's prior familiarity with and involvement in the case, the request is without legal basis and accordingly is denied.

However, applicant in fact alleges that Judge Bottorff was biased against applicant, and cites in support of that claim Judge Bottorff's allegedly "venomous" and "prejudicial" "personal attacks" on applicant contained in the Board's September 9, 1997 order denying applicant's motions to dismiss. The Chief Judge, having been one of the judges who signed the order in question, is familiar with the order and the history of the case leading up to the issuance of the order, and finds no basis for applicant's claim.

The September 9, 1997 order contains no "personal attacks" on applicant. Rather, the order accurately recounts the immediate prior history of the case, particularly with respect to applicant's detrimental practice of filing lengthy motions lacking in any basis in the Board's rules of procedure. The sanctions imposed on applicant by the Board were justified and well within the scope of the Board's discretion. Indeed, the order was carefully reviewed by the Chief Judge and by all of the other Administrative Trademark Judges and interlocutory

request for reconsideration is set forth below.

motions attorneys prior to its issuance and publication as citable precedent of the Trademark Trial and Appeal Board.

Applicant also contends that Judge Bottorff is biased against applicant because he has "ignored" and "blown off" applicant's efforts to point out to the Board opposer's alleged repeated violations of the Board's rules. The Chief Judge disagrees, seeing no basis in the record for applicant's charge. Judge Bottorff's prior interlocutory orders with respect to applicant's various motions for relief were appropriate under the Board's rules of procedure, and indeed were mandated by those rules.

Finally, applicant argues that Judge Bottorff, in his final decision in the case, demonstrated his prejudice against applicant by granting credence to opposer's testimony and disregarding "the facts" established by applicant during its cross-examination of opposer. The Chief Judge disagrees. The factual and legal bases for the Board's decision in this case are fully set forth in the Board's opinion, as are the Board's reasons for rejecting the factual and legal arguments presented by applicant. The fact that Judge Bottorff and the other judges on the panel were not persuaded by applicant's arguments is neither evidence of, nor the result of, any prejudice against applicant.

In summary, there is no basis in this record for the Chief Judge to remove Judge Bottorff from the panel deciding this case, nor for allowing a rehearing of the case by three different judges.

Decision: applicant's request for rehearing is denied.

J. D. Sams

Chief Administrative Trademark
Judge, Trademark Trial and Appeal
Board

REQUEST FOR RECONSIDERATION

Before **Seeherman, Wendel and Bottorff**, Administrative
Trademark Judges.

Opinion by **Bottorff**, Administrative Trademark Judge:

Applicant has filed a timely request for reconsideration of the Board's February 1, 2000 decision sustaining opposer's opposition to registration of applicant's mark DRUGBUSTERS, asserting that the Board committed various errors in reaching its decision. Opposer filed a timely brief in opposition to applicant's request for reconsideration.

Generally, the premise underlying a request for reconsideration under Trademark Rule 2.129(c) is that, based on the evidence of record and the prevailing authorities, the Board erred in reaching the decision it issued. The request may not be used to introduce additional evidence, nor should it be devoted simply to a reargument of the points presented in the requesting party's brief on the case. Rather, the request normally should be limited to a demonstration that, based on the evidence properly of record and the applicable law, the Board's ruling is in error and requires appropriate change. See TBMP §544 and cases cited therein.

The Board has carefully reviewed applicant's arguments, but is not persuaded that its decision in this case was in any way erroneous. Indeed, most of the arguments made by applicant in its request for reconsideration have previously been considered and rejected by the Board on one or more occasions in this case. Accordingly, applicant's request for reconsideration is denied. Because applicant is appearing pro se, the Board shall discuss each of applicant's arguments in more depth than would ordinarily be the case in an order denying a request for reconsideration of a final decision.

Applicant never moved to strike opposer's reply brief on the ground that it constituted improper rebuttal, or on

any other ground. To the extent that applicant is requesting such relief now (and it is not clear from applicant's request for reconsideration that this is the case), the request is manifestly untimely and accordingly is denied.

Opposer's filing of opposer's testimony deposition transcript with the Board was not untimely. Trademark Rule 2.125(c) sets no specific deadline for such filing. Moreover, it is applicant that is untimely in raising this issue for the first time in its request for reconsideration. Applicant's request that the deposition be stricken on this ground is denied.

Applicant's request that opposer's testimony deposition be stricken because it was signed before a notary public is denied. The Board already rejected applicant's arguments on this issue in its September 9, 1997 order denying applicant's February 10, 1997 and February 23, 1997 motions to dismiss. Applicant's request for reconsideration of that order is now untimely. See Trademark Rule 2.127(b). Moreover, and as previously explained by the Board, opposer's signature of the deposition before the notary public is in compliance with the requirements of Trademark Rule 2.123(e)(5). Contrary to applicant's contention, opposer was not required to sign the transcript before the officer who transcribed the deposition. See TBMP §713.10.

Applicant has not shown that the notary public before whom opposer appeared was not an "officer authorized to administer oaths."

Likewise, applicant's request that opposer's testimony deposition be stricken due to the alleged insufficiency of the notary public's certificate is denied. Again, the Board rejected applicant's arguments on this issue in its September 9, 1997 order, and applicant's request for reconsideration thereof is now untimely. Moreover, as discussed in footnote 2 of the Board's February 1, 2000 decision, the notary public's certificate was sufficiently affixed by being stapled to the deposition transcript filed with the Board. Applicant has not shown that the signature actually appearing on the transcript is not opposer's, or that the transcript is in any way an inaccurate record of opposer's testimony. As discussed by the Board in its decision, the purpose of the signature on the transcript is to ensure the accuracy of the transcript. Applicant cites no authority for its argument that the purpose of the signature requirement is to enable a subsequent perjury prosecution, if necessary. That argument overlooks the fact that the witness is "duly sworn" by the officer at the beginning of the deposition itself. See Trademark Rule 2.123(e); *Suthern Depo.* at 8.

Applicant argues in its request for reconsideration that opposer's testimony deposition should be stricken because opposer's service of a copy of the transcript upon applicant was one week late. That argument was rejected by the Board in its December 27, 1996 order denying applicant's July 29, 1996 motion to dismiss. Applicant's request for reconsideration of that order is untimely. See Trademark Rule 2.127(b). Moreover, as previously discussed by the Board, there is no basis in the Board's rules for the relief requested by applicant.

Applicant argues that the Board erred by believing the testimony of opposer. However, it is for the Board to determine the credibility and probative value of the testimony of witnesses. Applicant's disagreement with the Board's assessment of the credibility and probative value of opposer's testimony is no basis for reconsideration of the Board's decision.

Pursuant to applicant's request at page 13 of applicant's brief, the Board struck and gave no consideration to certain of the exhibits attached to opposer's testimony deposition, on the ground that those documents should have been, but were not, provided to applicant during discovery. Applicant now argues that opposer's failure to provide this information during discovery should result in the further sanction of dismissal

of the opposition. We disagree. Applicant already made this argument in its February 24, 1997 motion to dismiss, and the Board rejected the argument in its September 9, 1997 order. Applicant's request for reconsideration of that order is untimely. See Trademark Rule 2.127(b). Moreover, the Board remains of the opinion that the extreme sanction requested by applicant is wholly unwarranted under these circumstances, and finds that the sanction imposed upon opposer in the Board's final decision is sufficient and appropriate.

Applicant argues that the Board erred in refusing to strike and give no consideration to Exhibit 11 attached to opposer's testimony deposition (opposer's mailing label). The Board declined to do so in its February 1, 2000 decision because applicant had not identified in its brief, nor could the Board determine, which of applicant's document requests, if any, covered this document. Applicant, in its request for reconsideration, has now asserted that the document is covered by Document Requests Nos. 14 and 18. The Board has reviewed those document requests, and cannot conclude with certainty that Exhibit 11 in fact is responsive thereto and that it accordingly should be stricken from the record. Moreover, even if we were to strike that document, our decision in this case would not be affected in the least. Applicant relies on the mailing label to show that opposer

offers its goods via mail order, while applicant offers its goods via retail stores. However, as discussed at length in the Board's opinion, there are no trade channel restrictions in applicant's or opposer's identifications of goods and services, so any evidence regarding the actual trade channels of those goods and services is legally irrelevant.

With respect to footnote 3 of the Board's February 1, 2000 decision, applicant is advised that the Board has given no consideration to any of the affidavits or other documents applicant cited and attempted to "incorporate" into its brief on the case, except to the extent that any of those materials were properly made of record during the testimony periods in this case. This includes any documents or affidavits which had previously been submitted in connection with motions for summary judgment or otherwise. See *Levi Strauss & Co. v. R. Josephs Sportswear Inc.*, 28 USPQ2d 1464, n. 2 (TTAB 1993).

Finally, the Board adheres to its holding that applicant has failed to provide probative evidence of third-party trademark or service mark use of the term DRUGBUSTERS such as would lessen the scope of protection to be afforded to opposer's registered mark in our likelihood of confusion analysis. Furthermore, as discussed in the Board's February 1, 2000 decision, the Board has given no consideration to applicant's arguments that opposer has abandoned its mark by

failing to police third-party uses, or that the mark has devolved to the public domain as a result of such alleged failure to police. Those allegations are attacks on the validity of opposer's pleaded registrations which may not be heard in the absence of properly-asserted counterclaims for cancellation of the registrations. See Trademark Rule 2.106(b)(2)(ii). Applicant failed to assert those compulsory counterclaims, and therefore will not be heard to argue that opposer has abandoned its rights in the registered mark, or that the mark is now in the public domain.

No error having been shown, the Board's February 1, 2000 decision sustaining the opposition shall stand as issued.

Decision: The request for reconsideration is denied.

E. J. Seeherman

H. R. Wendel

C. M. Bottorff

Administrative Trademark Judges
Trademark Trial and Appeal Board